

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

JUL 31 2003

Ex parte SEAN R. WAKAYAMA

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application No. 08/917,480

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on July 21, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On December 19, 2002, appellant filed an Appeal Brief (Paper No. 35). A review of the file reveals that the Appeal Brief does not comply with section 1206(9) of the Manual of Patent Examining Procedure (August 2001) which states that "[t]he copy of the claims required in the brief Appendix by 37 CFR § 1.192(c)(9) should be a clean copy and should not include any markings such as brackets or underlining." Claim 19 in the Appendix to the Brief contains underlining and should be a clean copy according to MPEP § 1206(9).

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Furthermore, in the Examiner's Answer of March 31, 2003 (Paper No. 36), it is vague as to whether the rejection of claims 6, 16 and 18 under 35 U.S.C. § 112, second paragraph, is being maintained since such appears to be missing from the grounds of rejection. Also, it is unclear as to which rejection under 35 U.S.C. § 103(a) is being applied since there are two. Possibly, it may even be both of the rejections under 35 U.S.C. § 103(a) which are being applied. Clarification of these items are required.

Accordingly, it is

ORDERED that the application is returned to the examiner for filing of a corrected Appendix to the Appeal Brief, submission of a corrected or supplemental Examiner's Answer which clarifies the grounds of rejection, and for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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RA03-0459